

REMARKS

I. Status of claims

Claims 37, 38, 40-45, and 47-50 are pending in this application, By this Amendment, claims 37 and 44 have been amended, and claims 39, 46, 51, and 52 have been canceled. Applicant's specification fully supports these amendments. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

II. Claim Rejections

A. Rejection under 35 U.S.C. §112

Claims 51 and 52 have been rejected under 35 U.S.C. §112, first paragraph. The cancellation of these claims renders the rejection moot. Accordingly, withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

B. Rejection under 35.U.S.C. §102(e) of claims 35 and 36

Claims 37, 38, 40-45, and 47-50 have been rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,070,153 to Simpson. This rejection is respectfully traversed as it may be applied to the currently pending claims.

Simpson discloses a system in which a card issuer offers an investment account to customers having credit accounts. Simpson fails to disclose several features of the invention as set forth in claim 37. For example, Simpson fails to disclose issuance of a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer. Simpson additionally fails to disclose establishing a reward structure through an agreement between the financial institution and the

card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Because Simpson fails to show each and every element of claim 37, Simpson fails to anticipate claim 37. Claims 38 and 40-43 depend from claim 37 and therefore define over Simpson for the reasons set forth above.

Independent claim 44 defines over Simpson for similar reasons. Furthermore independent claim 44 requires simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution. Independent claim 44 further requires, upon a recipient's acceptance of an offer for multiple accounts, establishing the card payment instrument account in response to the acceptance and automatically creating the investment account in response to the acceptance. Simpson also fails to disclose these features.

Dependent claims 45 and 47-50, define further distinctive features of the invention and define over the art of record for at least the reasons set forth above with respect to claim 44. Accordingly, withdrawal of the rejection under 35 U.S.C. §102 is respectfully requested.

C. Rejection of Claims 39 and 46 under 35 U.S.C. §103

Claims 39 and 46 have been rejected under 35 U.S.C. §103 as being obvious over Simpson in view of U.S. Patent No. 5,513,102 to Auriemma. Although the rejection is moot with respect to canceled claims 39 and 46, the rejection is respectfully traversed as it may be applied to the currently pending claims.

Even if combined, Simpson and Auriemma fail to disclose the features of independent claims 37 and 44. While Auriemma does disclose the concept of co-branding, Auriemma fails to disclose establishing a reward structure through an agreement between the financial institution and the card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer. Auriemma further fails to disclose simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution and upon a recipient's acceptance of an offer for multiple accounts, establishing the card payment instrument account in response to the acceptance and automatically creating the investment account in response to the acceptance. Thus, even if modified by Auriemma as suggested in the Office Action, Simpson fails to arrive at the invention as claimed.

Furthermore, Simpson and Auriemma teach away from a method including establishment of a reward structure through an agreement between the financial institution and the card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer. "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). As illustrated in FIG. 3 and as explained in the Simpson specification, multiple funding methods are possible. All of these funding methods involve either card issuer funding, cardholder funding, or a combination of both methods. Furthermore, although Auriemma discloses co-branding, the system of Auriemma is not related to funding of an account and the card issuer bears the entire burden of providing rewards.

Accordingly, for at least the reasons set forth above, the references fail to render obvious the pending claims. Applicants respectfully traverse and request withdrawal of this rejection under 35 U.S.C. §103 as it may be applied to the currently pending claims.

D. Double Patenting

The Office Action rejects claims 51 and 52 under the doctrine of non-statutory double patenting. Claims 51 and 52 have been canceled, rendering this rejection moot. Accordingly, withdrawal of the rejection is respectfully requested.


III. Conclusion

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 07-1700.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

By:



Kerry H. Owens
Registration No. 37,412

Goodwin|Procter LLP
901 New York Ave., N.W.
Washington, D.C. 20001
(202) 346-4000

Dated: January 18, 2008